

REMARKS

This Amendment is submitted in response to the Office Action mailed on August 21, 2007. Claim 1 has been amended, and claims 1-5 remain pending in the present application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

In the present Office Action, the Examiner has maintained his prior rejections of claims 1-5 as being unpatentable over Pepicelli et al., U.S. Patent No. 4,257,268 in view of Smith, U.S. Patent No. 6,117,394. Applicants respectfully traverse these rejections for the reasons set forth below and respectfully request that the rejections be withdrawn.

At the outset, the Examiner appears to justify the combination of Pepicelli et al. and Smith by taking the position that it would have been obvious to one of ordinary skill in the art to provide the asserted "stabilizing member" (T_p) of Smith at the open distal end of the nose of Pepicelli et al. since Smith is directed to the problem of limiting the possibility of cross-contamination between samples (see Office Action, Pages 2-3 and 5). However, Applicants respectfully submit that the claimed stabilizing member of the present invention has nothing to do whatsoever with solving the problem of cross-contamination. Rather, the stabilizing member of the present invention is intended to solve the problem of wobbling encountered when smaller diameter pipettes

are inserted into the entry opening of the pipettor (see Page 2, lines 15-24 and Page 4, lines 19-23, for example, of Applicants' disclosure and Fig. 1 (labeled as Prior Art)). Consequently, Applicants respectfully submit Examiner has failed to establish a *prima facie* case of obviousness and the rejection of independent claim 1 should be withdrawn solely on this basis.

Examiner will note that Applicants have amended independent claim 1 to incorporate the language of the preamble, i.e., connecting or supporting pipettes of various sizes, into the body of the claim and so this claim language is entitled to patentable weight.

Examiner has cited *In re Ludtke* and other cases for the proposition that the functional language recited in independent claim 1 with respect to the radial confinement and support of pipettes of various sizes performed by the claimed stabilizing member is not entitled to patentable weight. Applicants respectfully disagree.

In particular, Applicants submit that *In re Ludtke* is applicable in a novelty rejection under 35 U.S.C. §102 rejection but cannot form the basis of an obviousness rejection under 35 U.S.C. §103.¹ Indeed, as the CCPA stated in *In re Ludtke*:

We agree with the Patent Office that the spacial separation between the panels is recited in functional language; however, as we said recently in *In re Swinehart* ([169 U.S.P.Q. 2d 226 (C.C.P.A. 1971)], ... there is nothing intrinsically wrong with the use of such claim language... Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing *novelty* in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.²

Applicants respectfully submit that there is ample precedent to establish that functional limitations are appropriate in claims and should be afforded patentable weight by the Examiner in an obviousness determination. For example, the Examiner is referred to *In re Mills* in which the Federal Circuit held that Examiners must afford

¹*In re Ludtke*, 169 U.S.P.Q. 2d 563, 566 (C.C.P.A. 1971); see also *In re Mills*, 16 U.S.P.Q. 2d 1430, 1432-33 (C.C.P.A. 1990) ("*Ludtke*, however, dealt with a rejection for lack of novelty, in which case it was proper to require that a prior art reference cited as anticipating a claimed invention be shown to lack the characteristics of the claimed invention. That proof would in fact negate the assertion that the claimed invention was described in the prior art. We are here, however, facing an obviousness issue.").

²*Id.* at 1432-33 (emphasis added).

patentable weight to functional limitations even if they are the only limitations that are nonobvious over the prior art.³

Examiner is also referred to in *In re Land* in which the CCPA stated:

It is true that the italicized portions [of claim 70] are "functional" but we do not regard that as good ground to give them "no weight" in view of the third paragraph [currently sixth paragraph] of 35 U.S.C. 112. We give them weight and with this limitation we think claims 70 and 71 are limited to deferred diffusion *built into the structure recited*, thereby being limited to the actual invention disclosed and hence allowable for the same reasons given by the board...⁴

In view of the above, Applicants respectfully submit that Examiner's position for rejecting independent claim 1 is error as a matter of law and the rejection should be withdrawn.

Moreover, as fully set forth in Applicants' Amendment mailed on June 7, 2007, Applicants respectfully submit that the proposed reconstruction and redesign of the Pepicelli et al. pipettor to include the pipette tip (T_p) of Smith is motivated solely by Applicants' own disclosure. Again, it is well settled that the mere fact that the prior art may be modified in the manner suggested by Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.⁵ It is

³*In re Mills*, 16 U.S.P.Q. 2d 1430, 1432-33 (Fed. Cir. 1990).

⁴*In re Land*, 151 U.S.P.Q. 621, 635-36 (C.C.P.A. 1966) (emphasis in original).

⁵*In re Fritsch*, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992).

improper to use Applicants' own disclosure as a "teaching tool" to teach the manner in which the prior art may be redesigned or reconstructed so that the claimed invention is rendered obvious.⁶

Applicants respectfully submit that Examiner has failed to establish a *prima facie* case that one of ordinary skill in the art would be motivated to modify the pipettor of Pepicelli et al. to include the pipette tip (T_p) of Smith, and further would be motivated to insert a pipette within the pipette tip (T_p) of Smith with the pipette tip (T_p) of Smith being configured to radially confine and support pipettes of various sizes received in the axial passageway of the pipettor with the pipettes extending through a distal end of the pipette tip (T_p) as claimed by Applicants in amended independent claim 1.

For the above reasons, Applicants respectfully submit that each of independent claim 1, and claims depending therefrom, recites a combination of elements not fairly taught or suggested by the prior art of record and the rejections should be withdrawn.

⁶*Id.*

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be resolved by telephone conference, the Examiner is invited to contact the undersigned in order to resolve the same and expedite the allowance of this application.

Please see the electronic fee calculation sheet for the charge in the amount of \$120 for the one month extension fee as required by 37 C.F.R. §1.17(a)(1). If any other fees are necessary, the Commissioner is hereby authorized to charge any underpayment or fees associated with this communication or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,

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